

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2222.5970001	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number 10/516,445	Filed November 30, 2004
		First Named Inventor ANDREW JAMIESON	
		Art Unit 3687	Examiner FRENEL, VANEL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 43,447

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Jason D. Eisenberg

Typed or printed name

(202) 371-2600

Telephone number



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 2996
ANDREW JAMIESON	Art Unit: 3687
Appl. No.: 10/516,445	Examiner: FRENEL, VANEL
Filed: November 30, 2004	Atty. Docket: 2222.5970001
For: Display Device and Funds Transaction Device Including The Display Device	

Arguments to Accompany the Pre-Appeal Brief Request for Review

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Mail Stop: AF

Sir:

Applicant hereby submits the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicant's arguments in the Reply under 37 C.F.R. § 1.111 filed December 31, 2008, filed in response to the Office Action mailed October 2, 2008, were not properly considered by the Examiner in the Final Office Action mailed March 17, 2009. Moreover, Applicant's arguments in the Reply under 37 C.F.R. § 1.116 filed May 18, 2009, filed in response to the Final Office Action mailed March 17, 2009, were not properly considered by the Examiner in the Advisory Action mailed June 9, 2009.

In particular, the Examiner has failed to properly address, in either the Final Office Action or Advisory Action, arguments first articulated in the Reply under 37 C.F.R. § 1.111 filed December 31, 2008 that independent claims 33, 48, and 55 each recite features that distinguish over the applied references, as again articulated below.

1. The Examiner Has Not Provided Applicant a Full and Fair Hearing

The Final Office Action rejected claims 33-64 as allegedly being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,016,480 to Houvener et al. ("Houvener") in view of U.S. Patent Application Publication No. 2001/0037249 to Fitzgerald et al. ("Fitzgerald"). Applicant respectfully traverses.

A significant portion of Applicant's Replies discussed in detail at least the below-noted distinguishing features of claims 33, 48, and 55. The Examiner does not properly

address the Applicant's arguments in order to meet the Examiner's burden for a *prima facie* case of obviousness. The Examiner's failure to properly respond to Applicant's arguments was improper in view of M.P.E.P. § 706.07, which states, "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." As a consequence of the Examiner's failure to properly address Applicant's arguments, Applicant finds it necessary to submit these Arguments for consideration by the Pre Appeal Conference before submitting an Appeal Brief.

2. *Claims 33-64 Are Not Rendered Obvious by the Combination of Houvener in View of Fitzgerald*

Independent claims 33, 48, and 55 each recite features that distinguish over the applied references. For example, claim 33 recites "a financial transaction controller coupled to the display, wherein the financial transaction controller selectively allows the display and an input device to operate under the control of the personal device to enable personal functions other than financial transactions to be performed," claim 48 recites "wherein the financial transaction controller selectively allows the display and the input device to operate under the control of the controlling electronics to enable personal functions other than financial transactions," and claim 55 recites "wherein the financial transaction controller selectively allows the input device and the display to be coupled to the controlling electronics to enable mobile telephone calls other than financial transactions."

In the Reply to Office Action dated December 31, 2008 (the Reply to Office Action), the Arguments of which are summarized below, but also fully incorporated by reference herein, Applicant argued in detail how at least the above-noted claim features distinguished from Fitzgerald, noting that the Examiner did not rely on Houvener as allegedly teaching or suggesting at least the above-noted claimed features. (Reply to Office Action, p. 12). These arguments were further detailed in the Reply under 37 C.F.R. § 1.116 filed May 18, 2009 (the Reply to Final Office Action).

First, Applicant noted in the Reply to Office Action that, assuming, to which Applicant does not acquiesce, a display located on the EFTPOS device of Fitzgerald is being used by the Examiner to be the display of claims 33, 48, and 55, Fitzgerald nowhere teaches or suggests allowing that display to be selectively under the control of either the EFTPOS device or the phone, as recited, using respective language, in claims 33, 48, and 55. In contrast, the only purpose of the phone in Fitzgerald, when integrated with the EFTPOS

device, is to serve as an access point to a communication network. (Fitzgerald at paragraphs 0042-43). Fitzgerald discloses as an advantage the ability to detach the cellular telephone from the EFTPOS device in paragraph [0047], and therefore teaches away from allowing the display on the EFTPOS device from being used for both EFTPOS and normal phone usage. Second, Applicant noted in the Reply to Office Action that Fitzgerald does not teach or suggest that any display on the phone is selectively under the control of the EFTPOS device, as recited, using respective language, in claims 33, 48, and 55.

Accordingly, it cannot be the case, absent the use of impermissible speculation and conjecture by the Examiner of what is taught by Fitzgerald, that Fitzgerald teaches or suggests at least the above-noted distinguishing features of claims 33, 48, and 55. Claims 34-47, 49-54, and 56-64 are also not rendered obvious by the combination of Houvener and Fitzgerald for at least the same reasons as claims 33, 48, and 55, from which they respectively depend, and further in view of their own respective features.

3. *The Examiner Has Provided A Deficient Reply in the Final Office Action and the Advisory Action*

In responding to the Reply to Office Action, the Examiner states in the Response to Argument section of the Final Office Action:

With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the teaching of Fitzgerald (See Fitzgerald, Fig. 3, Page 2, Paragraph 0034) which correspond (sic) to Applicant's claimed feature. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained. (Final Office Action, p. 11).

The Examiner then incorrectly states that "Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed." (Final Office Action, p. 12). Applicant respectfully submits that the purpose of the arguments presented, for example, on page 12 of the Reply to Office Action, was precisely to point to specific distinctions between the features disclosed in the references and the features that are claimed.

Not only has Applicant indicated specific distinctions, but has done so under two possible interpretations of how the Examiner's arguments could have been construed, without acquiescing to either, with regard to how the Examiner may have been applying Fitzgerald. The constructions considered by Applicant include, for example, that a display that is being controlled is alternatively on (a) the EFTPOS device or (b) on the phone. The Examiner has not provided further guidance in either the Final Office Action or Advisory Action which

interpretation being assumed by Applicant was actually intended by the Examiner. Nevertheless, Applicant has distinguished the instant claims over *both* interpretations, without acquiescing to either interpretation, and therefore the Examiner has failed to establish a *prima facie* case of obviousness for *either* interpretation.

The only guidance the Examiner provides on where to locate a teaching or suggestion in Fitzgerald regarding at least the above-noted distinguishing features of claims 33, 48, and 55 is FIG. 3 and paragraph 0034 of Fitzgerald. FIG. 3 is a diagram of the EFTPOS device, which has a display, element 12. Paragraph 0034 of Fitzgerald merely details the hardware elements of the EFTPOS device. Applicant finds it difficult to determine, based on this broad statement by the Examiner, the underlying reasoning behind the Examiner's argument as to why these sections teach or suggest the distinguishing features of the claims.

The Supreme Court held that "rejections on obviousness *cannot be sustained with mere conclusory statements*; instead, there must be some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550 U.S. 398 (2007). See also, M.P.E.P Section 2142. The Examiner has provided no such articulated reasoning or rational underpinning, instead restating the previous ambiguous rejection without any further guidance regarding how the subject matter of FIG. 3 and paragraph [0034] allegedly suggest at least the above-noted distinguishing features of claims 33, 48, and 55. Also, based on the Examiner's statements in the Final Office Action, the Examiner does not appear to have considered in detail, nor addressed in detail, the Applicant's arguments in the Reply to Office Action, which clearly articulated how the claims distinguish from the applied references.

Throughout pages 11-13 of the Final Office Action, the Examiner improperly, and without further articulation, appears to indicate the rejection relies on what is possibly suggested by, rather than explicitly taught by, the applied references. For example, the Examiner states that he has "satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and motivations for combinations *that fairly suggest* Applicant's claimed invention." (Office Action, p. 12) (emphasis added).

Also, for example, the Examiner states:

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is ... by what [the references] *would*

reasonably suggest to one of ordinary skill in the art... . (Office Action, p. 13) (emphasis added).

The Examiner's submission that “[t]he issue of obviousness is not determined by what the references expressly state but *by what they would reasonably suggest* to one of ordinary skill in the art,” is improper, as the Examiner has failed to provide the *KSR* required “articulated reasoning with some rational underpinning” as to what exactly those *suggestions* might be, relying instead on the improper, under *KSR*, “mere conclusory statements” that perceived *suggestions*, as interpreted, but not articulated by the Examiner, meet the claims. The Examiner is also reminded that the Examiner bears the initial burden of *factually supporting* any *prima facie* conclusion of obviousness, failing which, “the applicant is under no obligation to submit evidence of nonobviousness.” (M.P.E.P. § 2142).

In the Advisory Action, the Examiner restates the same broad arguments, and provides no resolution to the issues argued by Applicant.

In summary, the Examiner has not properly articulated the reasoning behind why the suggestion portions of the applied references should be interpreted outside of what is actually taught in the reference as suggesting at least the above noted distinguishing features. Thus, Applicant is provided no venue by which to advance prosecution, either through amendment, argument, or presentation of evidence.

4. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) of claims 33-64 over Houvener and Fitzgerald. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Jason D. Eisenberg
Attorney for Applicant
Registration No. 43,447

Date: 6/17/09

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
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